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PATENT

Docket No: 041892.0205

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

**Scott Jeffrey SHERR, Ira Steven RUBENSTEIN, Yair LANDAU, Andrew C. FRANK, Brian David LAKAMP, Bryan Gentry SPAULDING, Charles Jonathan EVANS, Everton Anthony SCHNABEL, Hartmut OCHS, Jeremy Eli BARNETT, Seth David PALMER, Todd Michael HENDERSON, William W. CHONG, Bruce FOREST, and Steven KOENIG**

Serial No. 09/828,406

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Filed: April 6, 2001

For: **WEBSITE SYSTEM AND PROCESS FOR SELECTION AND  
DELIVERY OF ELECTRONIC INFORMATION ON A NETWORK**

**PETITION IN SUPPORT OF FILING ON BEHALF OF  
OMITTED INVENTOR  
UNDER 35 U.S.C. 116 AND 37 C.F.R. 1.47**

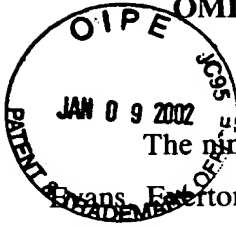
Pursuant to 37 CFR § 1.47(a), applicants herewith Petition the Commissioner to accept the accompanying Declaration executed by co-inventors Scott Jeffrey Sherr, Ira Steven Rubenstein, Yair Landau, Andrew C. Frank, Bryan Gentry Spaulding, and Seth David Palmer on behalf of themselves and omitted co-inventors Brian David Lakamp, Charles Jonathan Evans, Everton Anthony Schnabel, Hartmut Ochs, Jeremy Eli Barnett, Todd Michael Henderson, William W. Chong, Bruce Forest, and Steven Koenig.

Attorney for applicants has diligently attempted to reach the above-named omitted co-inventors without success, as documented in the Declaration accompanying this Petition. Therefore, applicants request that the Commissioner grant the instant petition and allow the above-named signing co-inventors to pursue the application, as provided by 37 CFR § 1.47(a), on behalf of the above-named omitted co-inventors.

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## OMITTED CO-INVENTORS' LEGAL OBLIGATION TO ASSIGN INVENTION

The nine omitted co-inventors (Brian David Lakamp, Charles Jonathan Evans, Easton Anthony Schnabel, Hartmut Ochs, Jeremy Eli Barnett, Todd Michael Henderson, William W. Chong, Bruce Forest, and Steven Koenig) signed a "Confidential Information and Invention Assignment Agreement" with Viant Corporation, assigning all their rights to any inventions which they conceived or developed or reduced to practice, or caused to be conceived or developed reduced to practice, during the period of their employment.

The above-referenced Agreements indicate that all of the nine omitted co-inventors were, at the time of signing the Agreements, employees of Viant Corporation. (See paragraphs 2 and 3 of the Declaration accompanying this Petition in support of these contentions.)

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In addition, Viant Corporation entered into a "Master Services Agreement" with Sony Pictures Digital Entertainment, Inc. wherein all right, title, and interest in and to any technology or information otherwise developed or created solely for Sony Pictures Digital Entertainment by Viant would be the property of Sony Pictures Digital Entertainment. (See paragraphs 4 and 5 of the Declaration accompanying this Petition in support of this contention.)

Therefore, the above-referenced agreements show that all nine of the omitted co-inventors have a legal obligation to assign all their right, title, and interest in and to the invention described in the above-designated application to the assignee, as indicated by the "Confidential Information and Invention Assignment Agreement" and "Master Services Agreement between Viant and Sony Pictures Digital Entertainment, Inc."

## DETAILS OF EFFORTS TO REACH OMITTED CO-INVENTORS

Applicants' attorney made diligent efforts to reach all nine of the omitted co-inventors without success. These efforts included contacting a Viant attorney and requesting that he assist in obtaining eight of the nine omitted co-inventors'

signatures on the assignment and declaration forms provided to him by the undersigned. The Viant attorney had earlier requested that the undersigned send communications to Viant inventors to him, rather than directly to the Viant employees.

In addition, the undersigned contacted an attorney employed by Sony Pictures Digital Entertainment and provided her with the last known mailing address of the ninth omitted co-inventor and requested that she assist in obtaining that omitted co-inventor's signatures on assignment and declaration forms provided to her by the undersigned.

Specifically, on September 26, 2001, the undersigned prepared and mailed a letter to Brennan Wall, Esq., a Viant attorney, requesting assistance in obtaining signatures from eight of the nine above-named omitted co-inventors. Enclosed in this letter to Mr. Wall were documents (application, declaration and assignment) for omitted co-inventors Charles Jonathan Evans, Everton Anthony Schnabel, Hartmut Ochs, Jeremy Eli Barnett, Todd Michael Henderson, William W. Chong, Bruce Forest, and Steven Koenig.

The undersigned requested that Mr. Wall have these eight omitted co-inventors review the documents and, if accurate, sign, date and return them to the undersigned. The undersigned also reminded Mr. Wall of the deadline for filing the documents. However, these eight omitted co-inventors either did not execute and return either of the declaration and assignment documents (Charles Jonathan Evans, Hartmut Ochs, and Jeremy Eli Barnett), or executed and returned only the assignment document (Everton Anthony Schnabel, Todd Michael Henderson, and William W. Chong). (See paragraphs 8 and 9 of the Declaration accompanying this Petition.)

In a further effort to reach omitted co-inventors Charles Jonathan Evans, Everton Anthony Schnabel, Hartmut Ochs, Jeremy Eli Barnett, Todd Michael Henderson, William W. Chong, Bruce Forest, and Steven Koenig, the undersigned prepared and mailed a letter to Mr. Wall, dated October 4, 2001, reminding him of the requirement that we obtain the signatures of these omitted co-inventors and again requesting his assistance in doing so.

However, neither the executed assignment and declaration forms of Charles Jonathan Evans, Hartmut Ochs, and Jeremy Eli Barnett, nor the executed declaration forms of Everton Anthony Schnabel, Todd Michael Henderson, and William W. Chong have been received by the undersigned as of the date of this Petition. (See paragraphs 10 and 11 of the Declaration accompanying this Petition.)

Thus, it is believed that the above-named eight omitted co-inventors are either unreachable at their last known addresses or are not cooperating.

In an effort to obtain executed documents from Brian Lakamp (the remaining omitted co-inventor), a letter, dated November 27, 2001, was prepared and mailed by the undersigned to Susie Oh, Esq., an attorney at Sony Pictures Entertainment. In the letter the undersigned requests assistance from Ms. Oh in having Mr. Lakamp review and execute the assignment and declaration documents enclosed in the letter. (See paragraph 12 of the Declaration accompanying this Petition.)

The undersigned also prepared and enclosed in the letter to Ms. Oh a letter addressed to Brian David Lakamp at his last known address as provided to the undersigned by Mr. Wall. Mr. Lakamp was asked in the letter to review the documents and sign and return the declaration and assignment documents to the undersigned no later than December 7, 2001. (See paragraphs 7 and 13 of the Declaration accompanying this Petition).

However, the executed assignment and declaration forms of Mr. Lakamp have not been received by the undersigned as of the date of this Petition. (See paragraph 14 of the Declaration accompanying this Petition.)

Thus, it is believed that Mr. Lakamp is either unreachable at his last known address or is not cooperating. It is further submitted that diligent efforts were made under the circumstances and that more than a reasonable effort has been made to

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obtain the signatures of all of the above-named omitted co-inventors on the assignment and declaration forms. Therefore, it is requested that the present Petition be granted.

Respectfully submitted,

Date

12-27-01

Ted R. Rittmaster  
Reg. No. 32,933

FOLEY & LARDNER  
2029 Century Park East, 35<sup>th</sup> Floor  
Los Angeles, CA 90067-3021  
(310) 277-2223 tel  
(310) 557-8475 fax

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EXHIBIT A

LIST OF PRIOR INVENTIONS  
AND ORIGINAL WORKS OF AUTHORSHIP

Title	Date	Identifying Number or Brief Description
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X No inventions or improvements  
       Additional Sheets Attached

*Charles Evans*  
Signature of Employee

Charles Evans  
Print Name of Employee

Date: 4/20/98

EXHIBIT B

VIA  
TERMINATION CERTIFICATION

This is to certify that I do not have in my possession, nor have I failed to return, any devices, records, data, notes, reports, proposals, lists, correspondence, specifications, drawings, blueprints, sketches, materials, equipment, other documents or property, or reproductions of any aforementioned items belonging to SILICON VALLEY INTERNET PARTNERS, its subsidiaries, affiliates, successors or assigns (together, the "Company").

I further certify that I have complied with all the terms of the Company's Confidential Information and Invention Assignment Agreement signed by me, including the reporting of any inventions and original works of authorship (as defined therein), conceived or made by me (solely or jointly with others) covered by that agreement.

I further agree that, in compliance with the Confidential Information and Invention Assignment Agreement, I will preserve as confidential all trade secrets, confidential knowledge, data or other proprietary information relating to products, processes, know-how, designs, formulas, developmental or experimental work, computer programs, data bases, other original works of authorship, customer lists, business plans, financial information or other subject matter pertaining to any business of the Company or any of its employees, clients, consultants or licensees.

I further agree that for twelve (12) months from this date, I will not hire any employees of the Company and I will not solicit, induce, recruit or encourage any of the Company's employees to leave their employment.

  
\_\_\_\_\_  
Signature of Employee

Charles Evans  
\_\_\_\_\_  
Print Name of Employee

Date: 4/20/96

## EXHIBIT C

### VIA CONFLICT OF INTEREST GUIDELINES

It is the policy of ~~SILICON VALLEY~~ <sup>INTERNET</sup> PARTNERS to conduct its affairs in strict compliance with the letter and spirit of the law and to adhere to the highest principles of business ethics. Accordingly, all officers, employees and independent contractors must avoid activities which are in conflict, or give the appearance of being in conflict, with these principles and with the interests of the Company. The following are potentially compromising situations which must be avoided. Any exceptions must be reported to the President and written approval for continuation must be obtained.

1. Revealing confidential information to outsiders or misusing confidential information. Unauthorized divulging of information is a violation of this policy whether or not for personal gain and whether or not harm to the Company is intended. (The Confidential Information and Invention Assignment Agreement elaborates on this principle and is a binding agreement.)
2. Accepting or offering substantial gifts, excessive entertainment, favors or payments which may be deemed to constitute undue influence or otherwise be improper or embarrassing to the Company.
3. Participating in civic or professional organizations that might involve divulging confidential information of the Company.
4. Initiating or approving personnel actions affecting reward or punishment of employees or applicants where there is a family relationship or is or appears to be a personal or social involvement.
5. Initiating or approving any form of personal, sexual or social harassment of employees.
6. Investing or holding outside directorship in suppliers, customers, or competing companies, including financial speculations, where such investment or directorship might influence in any manner a decision or course of action of the Company.
7. Borrowing from or lending to employees, customers or suppliers.
8. Acquiring real estate of interest to the Company.
9. Improperly using or disclosing to the Company any proprietary information or trade secrets of any former or concurrent employer or other person or entity with whom obligations of confidentiality exist.
10. Unlawfully discussing prices, costs, customers, sales or markets with competing companies or their employees.
11. Making any unlawful agreement with distributors with respect to prices.



12. Improperly using or authorizing the use of any inventions which are the subject of patent claims of any other person or entity.

13. Engaging in any conduct which is not in the best interest of the Company.

Each officer, employee and independent contractor must take every necessary action to ensure compliance with these guidelines and to bring problem areas to the attention of higher management for review. Violations of this conflict of interest policy may result in discharge without warning.